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-- REMARKS --

No new matter has been added with the addition of claims 15-20, support for which is found, inter alia, in the specification of United States Patent Application 09/997,745 at page 5, lines 1-18. Claims 15-20 are patentable over the prior art as the prior art does not disclose, teach, or suggest each and every claimed element.

Claims 1-13 were rejected as anticipated by Kojima. This rejection is traversed. Claims 1, 5, and 9 each require an orifice plate defining an orifice track having a first cross-sectional area; and a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area. The Examiner does not even allege that the 'slug' of Kojima is slidably disposed in the orifice track. Contrary to the Examiner's assertions, Kojima does not disclose a slug slidably disposed in the orifice track. Specifically, the Examiner likens the claimed slug with the "piston 48", and the orifice track with "opening 44A" but Kojima specifically discloses that the "piston 48 is inserted in the interior of the inner chamber 44 in such a manner as to be movable in the axial direction of the inner chamber." See, Kojima, column 5, lines 39-42. Thus, rather than sliding within the orifice track, the Kojima piston slides in the inner chamber 44.

The Examiner further likens the claimed orifice plate defining an orifice track with chamber 30 and opening 44A. However, as clearly illustrated by Kojima, the chamber 30 does not define opening 44A. See, FIG. 4 of Kojima. Kojima further discloses that the "other end of the passageway 42 is connected to opening 44A of the inner chamber 44" (column 5, lines 33-35), so that the opening 44A is defined by the inner chamber 44, rather than the chamber 30.

Since the piston of Kojima is inserted within a chamber, rather than a slug slidably disposed in the orifice track, and Kojima does not disclose that the orifice plate defines an orifice track, the §102(b) rejection of claims 1, 5, and 9 should be withdrawn.

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Claims 2-4, 6-8 and 10-13 depend directly or indirectly from claims 1, 5, or 9 respectively, and are therefore patentable over the prior art for at least the same reasons.

Claims 1-13 were additionally rejected as unpatentable over Ushijima in view of Aaron. This rejection is traversed. Ushijima in view of Aaron unequivocally teaches away from "a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area" as claimed in claims 1, 5, and 9.

There can be no motivation to combine Ushijima with Aaron, as the combination would destroy the principle of operation of Ushijima. *See*, MPEP §2143.02 and *In re Ratti*, 270 F.2d 810 (CCPA 1959). Ushijima teaches a mass member 24 that the Examiner likens to the claimed slug. However, were the mass member 24 modified to include any bore, much less a bore with a second cross sectional area less than the first cross sectional area, the invention of Ushijima would not function. Ushijima's mass member 24 is a "metal or synthetic resin" (column 3, lines 28-29) operates "by making the mass m2 of the mass member 24 larger than the mass m1 of the air inside the tubing 22" (column 3, lines 4-12). Thus, Ushijima operates because the mass member 24 has no bore – if modified to include a bore, the mass member 24 would not properly isolate vibrations, as the fluid on one side of mass member 24 and the air on the other side of mass member 24 could freely communicate through the mass member 24.

Ushijima specifically teaches that the mass member encourages the occurrence of resonance of the fluid inside the tube, whereby the vibrations are absorbed by means of the air-column resonance. (Abstract, Ushijima). In contrast, Aaron teaches that the bi-flow expansion device has non-symmetrical entrance-exits at the ends of the tubular member for changing the mass flow rate of refrigerant through the expansion device when the direction of refrigerant flow is changed.

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Additionally, the fact that the PTO classifies Ushijima and Aaron in different classes carries some weight, and serves as evidence of non-analogous art. *See, In re Ellis*, 476 F.2d 1370 (CCPA 1973).

Claims 2-4, 6-8 and 10-13 depend directly or indirectly from claims 1, 5, or 9 respectively, and are therefore parentable over the prior art for at least the same reasons.

Claim 14 was rejected as unpatentable over Kojima in view of Chikamori. This rejection is traversed. Claim 14 depends from claim 9 and is therefore allowable over the prior art for at least the same reasons.

Withdrawal of the rejections to claims 1-14 is requested.

Respectfully submitted,


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